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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,006	01/29/2002	Stephen Shannon	T3318-907402	3135
181	7590	06/01/2004	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			HOWELL, DANIEL W	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/058,006

Applicant(s)

SHANNON, STEPHEN

Examiner

Daniel W. Howell

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 9 is/are rejected.
- 7) ☒ Claim(s) 2,5-8 and 10-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2,3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant's election with traverse of claims 1-16 in the Paper filed 3-12-04 is acknowledged. The traversal is on the ground(s) that the examiner has failed to show how the apparatus can be used in a material different process. This is not found persuasive. In the first place, at the time a restriction requirement is made, an examiner is not required to show a reference explaining how the apparatus can be used in a materially different process. It is sufficient merely to explain how the apparatus can be used for a different process. Nevertheless, Applicant's attention is drawn to the Kiefer and Engler, III, et al references. Note that the base 50 of Kiefer has guide pins 58, and that this apparatus is being used on a workpiece not having floor covering over a template. Note that workpiece 60 is not even a floor member; it is a cabinet door, or such. Lines 11-25 of column 4 of Engler, III, et al describe an entirely different method which may be performed by the device of claims 1 and 9. Therefore, it is perfectly clear that the apparatus of present claims 1 and 9 may be used to perform a method other than that of claim 17.

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiefer.

Router base 46 may be equipped with a base plate 50. Both the plates 46 and 50 have openings for the cutter 48 (see opening 54 in plate 50). As seen in figure 2, guide members 58 extend on

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sides of the opening 54. In fact, many holes 56 are provided for the pins 58 to be located as desired. Figure 6 shows different sizes of guide pins that may be used.

4. Claims 1, 3, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Grisley.

Figure 1 shows a router base 18, a base plate 14 attached to base 18 by screws 17, and two guide pins 20, 22. Note the central openings for the cutter 24. As seen in figures 5 and 6, pin 20 has a beveled front end having a smaller diameter than that of pin 22.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Engler, III, et al.

Figure 1 shows a base 10 which is attached to the bottom of a router base. Figure 3 shows two pins 32A, B, which extend from the bottom side of base 10. Both of the bases have a central opening for the cutter.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Groves. Note router base 13, attachable base 10, pins 22, 24, and central openings for cutter 17.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kiefer. While figure 6 shows four sizes of pins, it does not explicitly state that one pin is 1/16 inch and another is 1/8 inch. As stated at column 4, lines 12-22, the pattern generated may be varied by changing and selecting various sizes of pins. It is considered to have been obvious to have made the pins

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of the diameters set forth in claim 4 to change the pattern on the workpiece as is artistically pleasing.

9. Claims 2, 5-8, and 10-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 703-308-1728. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Andrea Wellington, may be reached at 703-308-2159.

Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Center for Tech Center 3700 at 703-306-5648.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-1148.



Daniel W. Howell  
Primary Examiner  
Art Unit 3722